

### **REMARKS**

In the September 22, 2004 Office Action, the drawings were objected to and claims 1-19 stand rejected in view of prior art. It is noted that claim 20 was not treated in this Office Action thereby preventing a final action if another action is deemed appropriate. No other objections or rejections were made in the Office Action.

#### ***Status of Claims and Amendments***

In response to the September 22, 2004 Office Action, Applicant has amended the specification and claims 1, 2 and 16 as indicated above. Thus, claims 1-20 are pending, with claims 1, 2 and 16 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of above amendments and the following comments.

#### ***Drawings***

In paragraph 1 of the Office Action, the drawings were objected to as failing to comply with 37 CFR §1.83(a). In response, Applicant has filed herewith a Request for Approval of Proposed Drawing Corrections. Corrections were made to Figure 8 to diagrammatically illustrate brazing indicated by "X". Applicant believes that the drawings now comply with 37 CFR §1.83(a). Applicant respectfully requests withdrawal of the objections.

#### ***Specification***

Applicant has amended the specification to describe the diagrammatical illustration of the brazing in Figure 8.

#### ***Claim Objections***

In paragraph 2 of the Office Action, claim 1 was objected to because "[a] colon (:) should be inserted after the term 'including' for grammatical clarity." In response, Applicant has amended claim 1 accordingly. Withdrawal of the objection is respectfully requested.

***Rejections - 35 U.S.C. § 103***

In paragraph 3 of the Office Action, claims 1-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 416,190 (Terry). In response, Applicant has amended claims 1, 2 and 16 as mentioned above.

More specifically, independent claim 1 now recites, *inter alia*, that the spoke attachment portion includes a pair of annular side sections and an inner annular section to form a substantially U-shaped cross sectional shape with an annular hollow area. This arrangement is ***not*** disclosed or suggested by the Terry patent or any other prior art of record. It is well settled in U.S. patent law that the mere fact that the prior art can be modified does ***not*** make the modification obvious, unless the prior art ***suggests*** the desirability of the modification.

The Terry patent is directed to a felly H having a metal tire I. Terry shows a ***solid*** felly H in Figure 2 and states that the felly H is "of the usual construction" (p. 2, col. 1, l. 4) but does not specifically state the material. As shown in Exhibit A, the common definition of "felly" is a *wooden* rim. Terry does not provide motivation to modify the device. Therefore, it would not be obvious to modify the ***solid*** felly of Terry to attain the Applicant's unique arrangement of an annular hollow area formed between the spoke attachment portion and the tire attachment portion.

Original claim 2 has been incorporated into independent form. Claim 2 recites, *inter alia*, that each of the reinforcement members are bonded to the spoke attachment portion by melting metal to form a bond. This arrangement is ***not*** disclosed or suggested by the Terry patent or any other prior art of record.

The Office Action states on page 4 that it would be obvious to modify the felly of Terry by melting metal to form a bond between the mating surfaces. This modification of Terry would require a complete reconstruction of the device.

“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP §2143.02 citing *In re Ratti*, 123 USPQ 349 (CCPA 1959). Terry is directed towards a metal tire I encompassing a wooden felly H. The plates F cannot be bonded to the *wooden* felly H by melting metal. Indeed, because of the material of the felly H, Terry shows attaching the plates F to the felly H by bolts *h*. In order to accomplish what the Office Action proposes, the felly H, having a metal tire I, would have to be completely reconstructed with a metallic rim. The modification of Terry requires a complete reconstruction of the device and is therefore not obvious.

MPEP §2141.01 states that a reasonable expectation of success is the standard with which obviousness is determined. The Office Action has suggested bonding plates F with a wooden felly H by melting metal to form a bond between the surfaces. The Office Action is silent as to the expectation of success. Indeed, such a modification cannot be successfully made.

On page 5 of the Office Action, claim 16 stands rejected as being unpatentable over Terry in view of U.S. Patent No. 6,024,413 (Dixon et al).

Original claim 16 has also been incorporated into independent form. Claim 16 recites, *inter alia*, that the annular tire attachment portion includes an annular bridge section extending between a pair of annular tire support sections to form a substantially U-shaped cross-sectional shape. Applicant respectfully submits that this arrangement is *not* disclosed or suggested by the combination of Terry with Dixon et al.

The Terry patent is directed to a felly H having a metal tire I. Terry discloses a cavity G formed in the felly H. The cavity G receives the spoke head E and reinforcement member F such that a space g is formed inside the cavity G. Terry shows a solid felly H in Figure 2 and states that the felly H is "of the usual construction" (p. 2, col. 1, l. 4) but does not specifically state the material. As shown in Exhibit A, the common definition of "felly" is a *wooden rim*. In contrast, the rim of Dixon et al is hollow, is for a pneumatic tire and is made of an aluminum alloy or the like. Thus, the metal wheel of Dixon et al is so different from the wooden felly of Terry that one of skill in the art would not selectively combine the annular hollow area with the solid felly of Terry.

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP §2143.01 citing *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984). The Office Action proposes to modify the felly H of Terry with the rim of Dixon et al. This proposed modification would modify the invention of Terry such that it cannot perform its intended purpose. Terry relies on the solid, wooden felly H to form cavity G and space g as well as limit the movement of the spoke head E. See p. 2, col. 2, ll. 90-94 and Figure 2. If the felly H was somehow formed in the shape of the rim in Dixon et al, the spoke would not be limited by a cavity formed in solid material. Indeed, the spoke of the combination would not have the support given by cavity G and could even go through spoke access hole 40 when subject to stress. Without forming a cavity in a solid rim, the invention of Terry cannot perform its intended purpose. Therefore, there is no suggestion or motivation to make the proposed modification.

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP §2143.02 citing

*In re Ratti*, 123 USPQ 349 (CCPA 1959). The modification of Terry with Dixon et al requires a complete reconstruction of the invention of Terry. Terry is directed towards a metal tire I encompassing a solid, wooden felly H. The tire I, felly H and reinforcement member F are all held together by bolts *h*. Replacing the wooden felly H of Terry with the rim of Dixon et al would change the principle operation of the prior art invention being modified. That is, a complete reconstruction and redesign would be required in order to integrate a metal tire and reinforcement member, which are intended to be bolted to a solid wooden felly, with a hollow aluminum alloy rim.

MPEP §2141.01 states that a reasonable expectation of success is the standard with which obviousness is determined. The Office Action has suggested combining a metal tire and reinforcement member, which are intended to be bolted to a solid wooden felly, with a hollow aluminum rim for pneumatic tires. The Office Action is silent as to the expectation of success in such a combination. Indeed, such a combination cannot be successfully made.

On page 6 of the Office Action, claims 17-19 are rejected as being unpatentable over Terry in view of Dixon et al and U.S. Patent No. 6,443,533 (Lacombe et al). Applicant respectfully submits that the deficiencies in the combination of Terry and Dixon et al, as discussed above, are not remedied by the addition of Lacombe et al.

Moreover, Applicant believes that dependent claims 3-15 and 17-20 are also allowable over the prior art of record in that they depend from independent claims 1, 2 and 16 and therefore are allowable for the reasons stated above. Also, the dependent claims are further allowable because they include additional limitations. Thus, Applicant believes that since the prior art of record does not disclose or suggest the invention as set forth in independent claims 1, 2 and 16, the prior art of record also fails to disclose or suggest the inventions as set forth in the dependent claims.

Therefore, Applicant respectfully requests that this rejection be withdrawn in view of the above comments and amendments.

***Double Patenting***

In paragraph 7, claims 1, 4, 14, 16 and 17 were provisionally rejected under obviousness-type double patenting as being unpatentable over claims 1, 2, 6, 17 and 18 of copending Application No. 10/430,396. Applicant respectfully requests that this double patenting rejection be withdrawn in view of the amendments made in the present Application and Application No. 10/430,396.

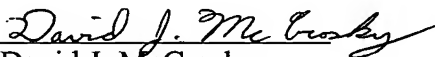
***Prior Art Citation***

In the Office Action, additional prior art references were made of record. Applicant believes that these references do not render the claimed invention obvious.

***Conclusion***

In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 1-20 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

Respectfully submitted,

  
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Dated: December 3, 2004

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Appl. No. 10/765,997  
Amendment dated December 3, 2004  
Reply to Office Action of September 22, 2004





**AMENDMENTS TO THE DRAWINGS:**

The attached sheet of drawings includes a change to Figure 8. This sheet replaces the original sheet including Figure 8. Corrections were made to Figure 8 to diagrammatically illustrate brazing indicated by "X".

Attachment: one (1) replacement sheet

<a href="#">Brainy:</a>	<a href="#">Atlas</a>	<a href="#">Encyclopedia</a>	<a href="#">Geography</a>	<a href="#">History</a>	<a href="#">Humor</a>	<a href="#">Quotes</a>	<a href="#">Time</a>	<a href="#">Translation</a>
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	<b>Dictionary Home</b>  <b>Quote of the Day</b> When love and skill work together, expect a masterpiece. <i>John Ruskin</i> <a href="#">more Famous Quotes</a>	  <input type="radio"/> Web <input checked="" type="radio"/> brainydictio
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**definition of felly****Felly**

(adv.) In a fell or cruel manner; fiercely; barbarously; savagely.

(n.) The exterior wooden rim, or a segment of the rim, of a wheel, supported by the spokes.

**Translation of felly**

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---- felly ----

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**More Fun With Words****Definition of Metanephros**

(n.) The most posterior of the three pairs of embryonic renal organs developed in many vertebrates.

**Definition of Miterwort**

(n.) Any plant of the genus Mitella, -- slender, perennial herbs with a pod slightly resembling a bishop's miter; bishop's cap.

**Definition of Jeffersonia**

(n.) An American herb with a pretty, white, solitary blossom, and deeply two-cleft leaves (Jeffersonia diphylla); twinleaf.



Exhibit A

## Print Preview **felly**

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**fel·ly** [ féllē ] (plural **fel·lies**) *or* **fel·loe** [ féllō ] (plural **fel·loes**)

noun

**wheel rim:** an outer rim of a wooden wheel, or a segment of this, with a metal tire shrunk around it

[Old English]

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